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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
RUSSELL J. THOMAS, ET AL. : EXAMINER: LOEWE, SUN JAE Y.
SERIAL NO: 10/565,557 :
FILED: JANUARY 23, 2006 : GROUP ART UNIT: 1609
FOR: ARYL DICARBOXAMIDES :

RESPONSE TO RESTRICTION REQUIREMENT

AND

ELECTION OF SPECIES

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the restriction/election of a single species requirement mailed March 1, 2007, Applicants provisionally elect with traverse the invention of Group II, Claims 10-17, and 19-21 drawn to a product of formula I, and for the single compound 5-[(3-cyclopentylpropanoyl)(4- {[(4-phenoxybenzyl)amino]carbonyl}benzyl)amino]-2-hydroxybenzoic acid.

Example 1 (see page 53 step e) both with traverse.

All of the claims essentially read on the elected invention (compounds) method of preparation and method of use.

The claims of Groups I, II, and III are integrally linked as compounds method for making and method of use. The Examiner has not made a convincing case why the claims should be divided.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (M.P.E.P. § 803). The burden of proof is on the Examiner to provide reasons and/or examples to support any conclusions in regard to patentable distinction. Compounds, method of making and the use thereof should be examined together. It is a technical relationship that defines the contribution which each of the Groups taken as a whole makes over the prior art.

In chemical cases a specified group of materials which do not necessarily belong to an otherwise class can be claimed together employing "Markush" language. The Markush practice sanctions the claiming together operable substances which could not be defined by generic language but which nevertheless have a community of chemical or physical characteristics. The members of the Markush group need only possess at least one property in common which is mainly responsible for their function in the claimed relationship. The same utility in a generic sense suffices. The accepted expression for a Markush grouping is "selected from the group consisting of".

Further, the MPEP at § 803 states as follows:

"If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

Applicants submit that a search of all claims would not constitute a serious burden on the Office. In fact the International Search Authority has searched all of the claims together. As the Office has not shown any evidence that restriction should now be required when the International Preliminary Report did not, restriction is believed to be improper.

For the reasons set forth above, Applicants request that the restriction requirement be withdrawn.

Applicants request that if the invention of Group II is found allowable withdrawn Groups I and III which include all the limitations of the allowable claims be rejoined.

Applicants request that should the elected species be found allowable, the Examiner expand the search to include non-elected species.

Divisional applications filed thereafter claiming the non-elected species should not be subject to a double patenting ground of rejection 35 U.S.C. § 121, In re Joyce (Comr. Pats 1957) 115 USPQ 412.

Applicants submit that the above-identified application is now in condition for examination on the merits, and an early notice of such action is earnestly solicited.

Respectfully submitted,

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